

Serial Number: 10/537,354
Attorney Docket: CHUC3006PCT-US

Remarks

Upon entry of this amendment, claims 1-6 will be in the case.

Claim 6 is a new claim and is being offered to permit the examiner to allow a claim even if the substance of the rejection is considered appropriate. Basis is found in claim 1 and the only difference between claim 1 and claim 6 is that change in shape and volume is recited further downstream in the claim.

It is noted that it is expected that claim 6 will not be entered. It is offered to permit the PTO to allow the case without conceding that its positions in the rejection are defective. However the undersigned considers the positions in the final action to be egregiously defective and has informed his client of this and has already been authorized to appeal and will appeal if allowability is not realized on the basis of the position below or new claim 6.

We turn now to the rejection. Claims 1, 2 and 5 are rejected under 35 U.S.C. 103(a) as being obvious over Hokkoku et al. (U.S. 4,032,488) in view of Uludag et al. (U.S. 2002/0015734). Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being obvious over Hokkoku et al. in view of Uludag further in view of Kim et al. (WO 00/12619) as evidenced by Lewis.

Reconsideration is requested. It is applicant's contention that the rejections are defective because the combination of Hokkoku et al. and Uludag et al. is misplaced.

Applicant has taken the position that the combination is defective because the claims rely on a concept of a pH sensitive, temperature sensitive hydrogel and the combination fails to teach this or even the concept of a pH sensitive hydrogel. The Office Action takes the position that temperature sensitivity and pH sensitivity don't count because the phrase relating to these is in a preamble and preambles don't count in assessing patentability. In response applicant contends that what the final rejection characterized as a "preamble" is not a "preamble" but rather is the product pursued. Moreover, new claim 6 moves reference to changing shape and volume further downstream in the claim so if "preamble" to the PTO means beginning of the claim, this position is no longer available.

Applicant has also taken the position that Hokkoku et al. lists fourteen specific

Serial Number: 10/537,354
Attorney Docket: CHUC3006PCT-US

unsaturated acid/anhydride/halide compounds and eighty-five specific olefin compounds, and even conceding the genus acrylamides is disclosed, selection requires one combination from over one thousand combinations that are possible and that this solution is *per se* unobvious. The rejection takes the position that the eighty-five olefins don't count because Uludag et al. teaches NiPAAM and that screening of fourteen acids would be within the realm of reasonable expectation to determine which one provides the desired result.

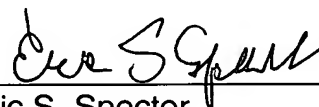
This is a defective position firstly because it is the PTO position that the desired result is not indicated in the claims so the "desired result" is unobvious.

This is a defective position secondly because the combination with Uludag et al. has to be based on Hokkoku et al. teaching the genus acrylamides for hydrogels and this is not the case. See 14/16-39 of Hokkoku et al. which is relied on in the Office Action of 29 November 2007 for this, but Hokkoku et al. at 14/16-39 teaches only dextran ester hydrogels where acrylamide is not involved.

Moreover, selection of NiPAAM based on Uludag would not be what would be reasonable or obvious because temperature sensitivity is not in the claims according to the final rejection.

Entry of the amendment and allowance are requested.

Respectfully submitted,
BACON & THOMAS, PLLC

By: 
Eric S. Spector
Registration No. 22,495

BACON & THOMAS, PLLC
Customer 23364
625 Slaters Lane - 4th Floor
Alexandria, VA 22314-1176
Telephone: (703) 683-0500
Facsimile: (703) 683-1080

Date: May 12, 2008